

No. 11761.

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

HERMAN H. HELBUSH and MONOGRAM MANUFACTURING
Co., a corporation,

Appellants,

vs.

DONALD H. FINKLE, doing business as WEDGELOCK COM-
PANY,

Appellee.

APPELLEE'S BRIEF.

FILED

APR 14 1948

PAUL P. O'BRIEN,
CLERK

LYON & LYON,

FREDERICK W. LYON,

811 West Seventh Street, Los Angeles 14,

Attorneys for Appellee.

TOPICAL INDEX

	PAGE
Jurisdiction	2
Statement of the Case.....	2
Summary of Argument.....	12
1. Both Patents in Suit Are Limited to a Clamp Having an Inner End Wall on the Body and an End Cover Cap Holding the Spreader in Place Between the End Wall and the Cover Cap	12
2. There Is Nothing Inventive Disclosed in the 787 Patent Over the Prior Patents to Rocroy and De Mooy.....	12
3. The Claims of the Patent 408 Are Invalid as They Constitute Nothing but a Collection of Old Elements Operating in Their Well-known Manner to Accomplish No New Results	12
4. Claim 11 of the 787 Patent Is Invalid as the Subject Matter of Said Claim Was in Public Use and on Sale More Than One Year Before the First Disclosure Thereof to the Patent Office.....	12
5. The Award of Attorneys' Fees to the Defendant in This Case Was Not an Abuse of Discretion.....	12
Argument	13
Both Parties in Suit Are Limited to a Clamp Having an End Wall on the Body and an End Cover Cap Holding the Spreader in Place Between the End Wall and the Cover Cap	13
There Is Nothing Inventive Disclosed in the 787 Patent Over the Prior Patents to Rocroy and De Mooy.....	19

The Claims of the Patent 408 Are Invalid as They Constitute Nothing but a Collection of Old Elements Operating in Their Well-known Manner to Accomplish No New Results..	23
Claim 11 of the 787 Patent Is Invalid as the Subject Matter of Said Claim Was in Public Use and on Sale More Than One Year Before the First Disclosure Thereof to the Patent Office	25
The Award of Attorneys' Fees to the Defendant in This Case Was Not an Abuse of Discretion.....	27
Conclusion	29

TABLE OF AUTHORITIES CITED

CASES	PAGE
Atlantic Works v. Brady, 107 U.S. 194, 197.....	21
Eagle, et al., v. P. & C. Hand Forged Tool Co., 74 F.2d 918 (C.C.A. 9)	22, 24
Haynes Stellite Co. v. Osage Metal Co., Inc., 110 F.2d 11, 14 (C.C.A. 10)	9, 11
Hubbell v. United States, 179 U.S. 77, 83.....	26
Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. 274, 279.....	26
Killefer Mfg. Co. v. Dinuba Associates, Limited, 67 F.2d 362, 366 (C.C.A. 9).....	17
Lorraine v. Townsend, 290 Fed. 54, 59 (C.C.A. 9).....	26
Magarian v. Detroit Products Co., 128 F.2d 544 (C.C.A. 9)....	22, 24
Mettler v. Peabody Engineering Corp., 77 F.2d 56, 57 (C.C.A. 9)	22, 24
Monogram Mfg. Co. v. F & H Mfg. Co., 144 F.2d 412.....	5, 11, 20, 22, 27, 28
Muncie Gear Works v. Outboard M. and Mfg. Co., 315 U.S. 758, 768	25, 26

CODES

28 U.S.C.A., § 41 (Judicial Code, § 24(7)).....	2
28 U.S.C.A., § 230	2
35 U.S.C.A., § 31 (R.S.U.S. 4886).....	25, 26
35 U.S.C.A., § 70	27

No. 11761.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

HERMAN H. HELBUSH and MONOGRAM MANUFACTURING
Co., a corporation,

Appellants,

vs.

DONALD H. FINKLE, doing business as WEDGELOCK COM-
PANY,

Appellee.

APPELLEE'S BRIEF.

Plaintiffs, Herman H. Helbush and Monogram Manufacturing Co., have appealed from a judgment of the District Court dismissing an action based upon a claim of infringement of claim 11 of United States Letters Patent No. 2,365,787, and claims 1 and 2 of United States Letters Patent No. 2,364,408. Originally the complaint included a charge of infringement of claims 1 to 7, inclusive, of United States Letters Patent No. 2,320,493.

Defendant, Donald H. Finkle, filed an answer denying infringement and alleging that the patents were invalid on several grounds and counterclaimed charging the Monogram Manufacturing Co. with infringement of United States Letters Patent No. 2,393,088, owned by defendant. By stipulation the charge of infringement as to patent No. 2,320,493 and defendant's counterclaim

were dismissed. Defendant Wedglock Company, a corporation, was brought into the action as a defendant by supplemental complaint filed pursuant to stipulation of the parties [R. 20].

Jurisdiction.

This suit arises under the Patent Laws of the United States as it involves questions of validity and infringement of said Letters Patent (Judicial Code, § 24(7), 28 U.S.C.A. 41).

The appealed judgment was filed and entered on May 20, 1943 [R. 33]. Motion for a new trial was filed by plaintiffs on May 28, 1947 [R. 35] and an Order of the District Court denying plaintiffs' Motion for a New Trial was entered on June 25, 1947 [R. 55]. Notice of Appeal was filed September 23, 1947 [R. 55], within three months of the entry of the Order Denying Plaintiffs' Motion for a New Trial (28 U.S.C.A. 230).

Statement of the Case.

The District Court found that plaintiff-appellant, Herman H. Helbush, was and still is the owner of all right and title in United States Letters Patent No. 2,365,787, and in United States Letters Patent No. 2,364,408, and that the plaintiff-appellant, Monogram Manufacturing Co., has the exclusive right to manufacture, use and sell the inventions of said United States Letters Patent [R. 25, 26].

The Court further found that the defendants, Donald H. Finkle and Wedglock Company, engaged in the manufacture and sale of sheet metal clamps prior to or subsequent to the issuance of said Letters Patent [R. 26] and that said clamps do not constitute infringement of said Letters Patent [R. 26, 32, 34].

The defenses pleaded by appellees to both patents are:

1. Noninfringement [Amend. Answer, R. 7];
2. That Frank C. Wallace was not the original or first inventor of that which is alleged to be patented in the respective patents, or any material or substantial part thereof, and that all substantial parts thereof had been described and patented in the prior patents set forth in Paragraph 7 of the Amended Answer [R. 7-8];
3. That in view of the state of the art at and before the alleged inventions of the patents the claim or claims of said patent or patents cannot now be so interpreted as to bring within their purview as an infringement thereof any clamp manufactured by defendants [R. 9];
4. That both patents are invalid and void because that which is disclosed and claimed therein did not require invention in view of the state of the art existing at the time of the alleged invention thereof by Wallace [R. 10].

The District Court found that appellees did not infringe either of the patents in suit, but did not pass upon the other defenses [R. 26, 32, 34].

The first Wallace patent in suit, No. 2,365,787, was granted December 26, 1944, on an application filed April 7, 1941. The second Wallace patent, No. 2,364,408, was granted December 5, 1944, on an application filed April 9, 1943.*

*Hereinafter these patents will be referred to as the "787" and "408" patents; *i.e.*, by the last three digits of their numbers.

In the aircraft industry, the external metal sheets or plates forming the skin of a plane must be riveted together. The plates are superposed upon one another over the internal framework. Registering rivet holes are provided in the superposed sheets and framework. In some instances the rivet holes in the sheets and framework are punched or drilled in advance of assembly; in other instances such registering rivet holes are punched or drilled in the sheets and in the framework at the time the sheets are brought into position on the framework. The sheets are riveted together and to the framework. In order to provide for proper riveting of the sheets and framework, it is necessary to hold in exact coaxial alignment the rivet holes of the sheets and framework while the permanent rivets are inserted and secured. Originally, in this industry, a nut and bolt were used for this purpose. The Wallace patents are concerned solely with temporary clamps for holding the sheets upon the framework while the permanent rivets are inserted and fastened.

Several years prior to the recent war various types of removable clamps or temporary rivets were used both in this country and abroad.

Cf. Patent to Le Blanc, No. 2,136,875 [Exhibit H-5, R. 307].

British Patent to A. T. S. Co., Limited, No. 413,403 [Exhibit H-3, R. 297].

British patent to Rocroy, No. 443,683 [Exhibit H-4, R. 303].

Patent to De Mooy, No. 2,159,655 [Exhibit H-6, R. 313].

Patent to De Mooy, No. 2,269,188 [Exhibit H-7, R. 317].

Patent to Webb, No. 2,256,634 [Exhibit H-8, R. 323].

Patent to Rogers, No. 2,276,344 [Exhibit H-9, R. 331].

While the two Wallace patents refer to the devices described and claimed therein as a “clamp” and a “sheet metal clamp” the terms “temporary rivet,” “skin clamp” and “sheet fastener” are used by the witnesses as synonymous in referring to removable fastening devices used for holding rivet holes in superposed sheets in coaxial alignment.

The advantages of such a clamp or temporary rivet over the ordinary nut and bolt, lie in the fact that the temporary rivet can be readily and quickly inserted and removed by a single operator at the exterior of the work and without the loss of time otherwise incident to the threading together and separation of the nut and bolt, which also requires two operators, one on each side of the sheets which are to be held together (*Monogram Mfg. Co. v. F & H Mfg. Co.*, 144 F. 2d 412).

Neither of the Wallace patents makes any claim to being more than improvements on existing clamps for temporary rivets (Appellants’ Brief 5, 6).

The clamp illustrated and described in patent No. 787 is admittedly only an improvement upon prior art patents, best illustrated by the British patent to Rocroy, No. 443,-683, Exhibit H-4, and the United States patent No. 2,269,188 to De Mooy, Exhibit H-7. The 787 patent and these two prior patents, Exhibits H-4 and H-7, describe a clamp comprised of a body member within which is a slidably mounted retaining pin. This retaining pin extends outwardly through a hole at one end of the body.

A spreader is positioned to spread the halves of the retaining pin apart. The inner end of the retaining pin carries a means for retracting the pin against the end wall of the body adjacent to the hole. The retaining pin has projections or enlargements which cannot pass through the hole because the combination of the spreader extending outwardly from the body and the halves of the pin and the projections are larger than the hole. In order to insert the clamp into the registering rivet holes of the sheets of material to be held together or to withdraw it therefrom it is necessary to force the ends of the retaining pin outwardly from the end of the body until the projections on the pin are extended beyond the spreader. Thereupon the halves of the pin can spring together so as to allow them to be inserted within a rivet hole. Retracting the pin against the end of the body causes the halves to be spread by the spreader and the projections hooked over the edges of the sheets surrounding the rivet holes, thus securely clamping the sheets between the projections upon the pin and the end wall of the body.

The only physical difference between the disclosures of the Rocroy patent, Exhibit H-4, and the De Mooy patent, Exhibit H-7, is that the means for retracting the pins to hold them in a clamping position comprise a nut threaded upon the pin in the Rocroy clamp which is tightened up to pull the pins against the end of the body. In the De-Mooy patent there is a spring replacing the nut and engaging the inner end of the body and a cap upon the pin to yieldably retract the pin into the body.

The Wallace 787 patent uses a spring similar to De Mooy rather than the nut of Rocroy. The only other difference is that Wallace places his spreader in a slot on the exterior of the end wall of his body and covers the

spreader with a cover cap 27. Rocroy and De Mooy do not have this cover cap 27. In De Mooy the spreader is held on the exterior of the end wall by merely crimping the edges of the slit over the spreader [R. 319, Col. 1, line 52, to Col. 2, line 7]. The purpose of the cover cap 27 in the Wallace patent 787 is to provide "a minimum contact surface . . . to minimize the chance of marring the surface of the work." [R. 279, Col. 2, lines 18-20.] Nowhere does the Wallace patent 787 claim any other purpose for or advantage in the cap 27.

In the 787 patent Wallace's claim of invention is thus restricted to the provision of this end cover cap 27 over Rocroy and De Mooy. All the other elements of his clamp were old in substantially the same clamp and acting in the same manner and for the same purpose.

The Wallace patent 408 is similar to the Wallace patent 787 and Rocroy and De Mooy, Exhibits H-4 and H-7, with one exception. This patent, after describing identically the same device as the three above mentioned patents, adds another element which comprises a thimble 17 mounted to form a cover over the retaining pin and its spring. Inwardly extending from the inner surface of the body is a shoulder 16 which acts as a stop to limit the outward movement of the thimble 17. The purpose of Wallace in the alleged invention of the 408 patent was to prevent the retaining pins from being hurled outwardly from the body if they should so break that the projections would no longer limit their movement through the holes in the end wall. This was accomplished by a shoulder upon the thimble 17 which engaged a shoulder 16 upon the inner bore of the body which struck against each other if the retaining pins broke. However, this cooperation of a shoulder upon a thimble with a shoulder

upon the body was not new with Wallace. It is disclosed in the patent to Webb, No. 2,256,634, Exhibit H-8 [R. 323]. This Webb patent discloses a cap 16 upon the retaining pin which has a shoulder to engage a shoulder extending inwardly from the body [R. 325, Col. 2, line 44, to R. 326, Col. 1, line 1]. Wallace 408 discloses nothing new over Rocroy, De Mooy and Webb except the cover cap 11 to engage the work.

At the trial appellants elected to stand upon claim 11 of the 787 patent and claims 1 and 2 of the 408 patent. The appealed judgment is based upon these claims [R. 34].

The claim in suit of the 787 patent specifies a combination of the following elements or parts:

- (a) A cylindrical body (round body 10);
- (b) A laterally flexible retaining member reciprocatively mounted in the body for protraction and retraction through the outer end of the body;
- (c) A spreader bar having lateral sliding engagement with the retaining member, said spreader having an angular disposed inner end portion;
- (d) Means for holding the spreader bar against outwardly longitudinal movement relative to the body consisting of a cover cap having a cylindrical skirt secured to the outer end portions of the body periphery;
- (e) And an end wall whose inner surface provides an abutment for the angular portion of the spreader bar and whose outer surface provides a sheet engaging portion.

While this claim does not specifically disclose or specify that a spring shall be incorporated in the clamp to yield-

ably hold the retaining member retracted, a spring is necessary to the described operation of the device and must be read into this claim so that an operative combination is disclosed and specified. There would be no clamping action of the specified elements without the coil spring 31.

The District Court interpreted claim 11 and decided that the patented invention consisted of a body 10 having an end wall 12 and a cap 27 holding a spreader (cross bar 25) between said end wall 12 and said cap 27. This interpretation of the Court is disclosed in Findings of Fact 24 and 25 [R. 29] wherein the Court found that defendants' clamps do not have an end wall on the body and the clamps had two-piece bodies; *i. e.*, a cylindrical tube closed by a cap at one end. Plaintiffs' expert testified:

"Q. There is no difference in putting those two parts together than there is in putting the bottom on an ordinary tin can?

* * * * *

"A. That is a fairly good statement of it; yes."
[R. 153-154.]

Obviously as defendants' clamps [illustrated by Exhibits 11 and 12] do not have an end wall 12 and only a cap they do not infringe.

"Every element of a combination claim for an apparatus * * * is conclusively presumed to be material. The omission of one element, * * * of the claim avoids infringement of that claim, whether or not the omitted element, operation, or step is essential to the combination." (*Haynes Stellite Co. v. Osage Metal Co., Inc.*, 110 F. 2d 11, 14 (C.C.A. 10).)

As Wallace 787 only describes a body having an end wall 12 (contrasted with a hollow tube like defendants'), the Court correctly limited the term "a cylindrical body" of claim 11 to a cylindrical body having an end wall 12.

The claims of the 408 patent in suit are claims 1 and 2. Appellants have chosen claim 2 as typical. This claim specifies a combination of the following elements or parts:

- (a) A cylindrical body;
- (b) An end cap mounted on the body in position closing the outer end thereof;
- (c) Said cap presenting an opening therethrough and a work-engaging outer surface;
- (d) A plunger reciprocally mounted in the body, said plunger having a work-engaging member protractable and retractable through said opening;
- (e) A spreader member having a laterally projecting inner end portion disposed in the cap and an outer end portion projecting outwardly through said opening in engagement with the work-engaging member;
- (f) An inwardly disposed flange on the inner surface of the body adjacent its inner end;
- (g) A coil spring in the body around and retractively engaging the plunger and tool operated means for protracting the plunger against the pressure of said spring;
- (h) Comprising a plunger-engaging member reciprocally mounted in and projecting from the inner end of the body for manual engagement, said member having a relatively increased diameter inner end portion engageable against said flange when the plunger is in fully retracted position.

As with respect to the 787 patent, the Court construed “a cylindrical body” in this 408 patent to specify a body having a wall inside of the cap. This end wall is described as a ring member 9 [R. 285, col. 1, lines 53-55]. Only clamps similar to Exhibit 11 are charged to infringe the 408 patent (Appellants’ Opening Brief, p. 26). These clamps do not have an end wall inside of the cap. The Court therefore found that they did not infringe the claims of the 408 patent. *Haynes Stellite Co. v. Osage Metal Co.*, *supra*.

The Final Judgment herein awarded defendants “reasonable attorneys’ fees herein adjudged to be \$500.00.” The record in this case shows that the principal defendant (Donald H. Finkle) has been continually harassed by law suits by the plaintiffs. He has had to defend against four patents owned by plaintiffs. These are the two patents here in suit and the two patents found invalid by this Circuit Court. *Monogram Mfg. Co. v. F & H Mfg. Co.*, 144 F. 2d 412.

SUMMARY OF ARGUMENT.

1. BOTH PATENTS IN SUIT ARE LIMITED TO A CLAMP HAVING AN INNER END WALL ON THE BODY AND AN END COVER CAP HOLDING THE SPREADER IN PLACE BETWEEN THE END WALL AND THE COVER CAP.

As neither of appellees' clamps has an end wall and has only an end cap, they do not infringe either patent in suit [Findings of Fact 12-15, R. 26].

2. THERE IS NOTHING INVENTIVE DISCLOSED IN THE 787 PATENT OVER THE PRIOR PATENTS TO ROCROY AND DE MOOY.

The 787 patent mechanically in function and parts is identical with the patents to Rocroy and De Mooy.

3. THE CLAIMS OF THE PATENT 408 ARE INVALID AS THEY CONSTITUTE NOTHING BUT A COLLECTION OF OLD ELEMENTS OPERATING IN THEIR WELL-KNOWN MANNER TO ACCOMPLISH NO NEW RESULTS.

The 408 patent has no new elements or functions and does not describe a patentable combination.

4. CLAIM 11 OF THE 787 PATENT IS INVALID AS THE SUBJECT MATTER OF SAID CLAIM WAS IN PUBLIC USE AND ON SALE MORE THAN ONE YEAR BEFORE THE FIRST DISCLOSURE THEREOF TO THE PATENT OFFICE.
5. THE AWARD OF ATTORNEYS' FEES TO THE DEFENDANTS IN THIS CASE WAS NOT AN ABUSE OF DISCRETION.

ARGUMENT.

Both Parties in Suit Are Limited to a Clamp Having an End Wall on the Body and an End Cover Cap Holding the Spreader in Place Between the End Wall and the Cover Cap.

To interpret the claims of the two patents in suit the District Court had to first determine what (if anything) was new in the patented combination. In both patents the Court determined that the only new thing was a body having an end wall thereon with the spreader mounted on the outside of that end wall and held in position by a cover cap. The 787 patent describes a clamp having the following elements:

- (1) A body member in which is slidably mounted
- (2) A flexible retaining pin with
- (3) A spreader held between the legs of the retaining pin to hold them apart, and
- (4) A spring to urge the pin inwardly of the body so that
- (5) Projections on the ends of the halves of the retaining pin extending from the body will clamp perforated sheets between the projections and the end of the body.

There can be no dispute that such a combination was old in the art [Rocroy, Exhibit H-4, and De Mooy, Exhibit H-7]. Both Rocroy and De Mooy clearly disclose such a combination. Therefore, the difference between the clamp of the 787 patent and the clamps of these two prior patents must be found in the manner of holding the spreader on the body. Rocroy does not fully disclose how he holds the spreader in position. He merely states

that it shall be fixed in the body "Between the arms 4 and 5, there is fitted into the slot 3 a slide 11 of inverted T-shape of which the cross piece or base 12 is secured to a sleeve 13 capable of sliding on the screwed rod," [R. 304, lines 52-56].

De Mooy describes the positioning of his spreader as attached to the end wall of the body by being positioned in a slot wherein it is held by having the lips of the slot peened over; that is, bent over the edges of the slot to partially close same [R. 319, col. 1, line 52, to col. 2, line 3]. These two prior patents both show the manner of fixing the spreader upon the body. All that Wallace did was to take the De Mooy fastener and instead of "closing the outer ends of the groove" to hold the spreader in position, he put a round cap member over the cross arms of the T-shaped spreader and crimped this cap upon the sides of the body. He still retained the end wall on his body. The reason for doing this is explained in the patent in suit where he states that the purpose of the cap 27 is to prevent "marring the surface of the work" [R. 279, Col. 2, lines 14-20]. Any ordinary mechanic would understand that a tool of this type should have the end of the body rounded off.

Although the purpose of the end cap as described in the 787 patent is to prevent damage to the work, the testimony clearly shows that there was another purpose in using an end cap in the commercial clamp of appellants. That purpose was to permit the device to be cheaply assembled [R. 89]. Testimony further states that the appellants could not figure out a way of assembling a clamp having a one-piece body (that is, no end cap) that could be constructed sufficiently cheap to compete with their competitors [R. 96-99]. The one-piece body clamp took

the appellants “three times as long to assemble” as the type having a body with an end wall and a spreader and cap on its outside [R. 91-92]. They therefore went to the two-piece body comprising the body with an end wall and a spreader and cap on the outside. By such a construction the appellants were able to insert the retaining pin through the hole in the end of the body member without the use of a jig and then insert the spreader between the legs of the retaining pin on the outside of the body, slip the cap over the spreader and pins and the device would be complete [R. 92]. The difficulty in assembling the one-piece body was that the hole in the wall was not larger than the combined width of the projections on the ends of the retaining pin and it was difficult to insert the spreader and pins from the inside of the body through the end wall [R. 92]. Appellees had no such difficulty. As adequately displayed to the lower court, defendants constructed a jig which could be operated by an inexperienced girl and which permitted the spreader and pins to be inserted from the inside of the body through the end wall obviating the use of an end cap [R. 226]. By the use of this jig appellees assembled all of their clamps [R. 223, 265-268]. Appellants expressly admitted that they could not accomplish this type of assembly and had no jigs to assemble this type of device [R. 99]. Appellees later on developed two clamps, Exhibits 11 and 12, which have an end cap. These are the alleged infringing clamps. This end cap is entirely different and for a different purpose than that of the 787 patent. The purpose of this end cap was to permit the appellees to use a simple tubular shaped body *without any end wall*. This type would be cheaper to construct than a complete body having an end wall. This construction was cheaper as it saved weight in the body

and in the amount of steel necessary. A simple stamping could be made of a cap out of relatively thin steel and this could be crimped to the body to form its end wall. Actually all that appellees did was to construct their body as a two-piece device [Finding of Fact 25, R. 29]. Such a construction is old and well known in forming cylindrical tubes with bottoms such as tin cans [R. 153-154].

Another reason for so constructing appellees' Exhibits 11 and 12 with the two-piece body was that they could be assembled by a subassembly method. The spreader, pins and cap and spring could be assembled as a unit and inserted into the body and the end cap crimped to the body to form the completed tool. The device described in the 787 patent could not be so assembled as there is an end wall 27 upon the body, which would prevent the positioning of the subassembly in the body. To illustrate the correctness of the lower court's decision that defendants' clamps, Exhibits 11 and 12, do not infringe the 787 patent, because they do not have an end wall on the body, all that it is necessary to show is that the subassembly, Exhibit E, actually is a full and complete clamp in itself [R. 147-148] not differing from the older type of defendants' clamp, Exhibit C, in any particular other than the size and shape of the body itself. Appellants' own expert stated: "Yes, I think functionally they are the same." [R. 147.] All of the operating parts of appellees' clamps, Exhibits 11 and 12, are incorporated in Exhibit E. Appellants' expert admitted they were identical in function with the older Exhibit C. Therefore

if Exhibits 11 and 12 infringed the patent in suit, so would Exhibits C and E, and as they do not differ from Rocroy and De Mooy, they either do not infringe or the patent is anticipated. *Killefer Mfg. Co. v. Dinuba Associates, Limited*, 67 F. 2d 362, 366 (C.C.A. 9).

All that has been said heretofore about the 787 patent applies directly to the 408 patent. The only additional elements of the 408 patent that are not included in the 787 patent are the shoulders which prevent the cap from exploding. These are the shoulders 16 extending inwardly from the body and the shoulder upon the cap 17 which engages the shoulders 16 to prevent the cap and retaining pins from being hurled outwardly from the body if the retaining pins break. Appellants have urged that this patent has a double safety feature. Nowhere in this patent, and it cannot be found from the drawings or description, is there any other safety feature than the one just described; that is, the shoulders. The shoulders prevent the cap, spring and retaining pin from being hurled from the body in the direction to the right in the drawings of the patent if the retaining pins break. Nothing could be hurled from the other side. The projections or enlargements 20b on the ends of the retaining pin do not function any differently in this patent than they do in all of the other art. They do not act as a safety lock in any stretch of the imagination. If they are broken, the shoulders will engage and stop the explosion of the tool. Whether or not they are intact the shoulders are the only devices that would prevent an explosion of the tool. These safety shoulders, which are the only pos-

sible novelty in the 408 patent, are clearly described in the Webb patent, Exhibit H-8, wherein he shows a retaining pin in a body which has a cap thereon and a spring to force the retaining pin outwardly from the body. In this patent he clearly describes a shoulder which he calls lips 15 [R. 325, Col. 2, lines 40-43], and a shoulder 20 upon the cap [R. 325, Col. 2, lines 48-51]. This body and cap with the two shoulders are identical in form to the 408 patent and are for the same purpose as that patent. They are there to prevent the cap from moving out of the end of the body [R. 325, Col. 2, line 51, to R. 326, Col. 1, line 1]. The 408 patent differs from Webb, Rocroy and De Mooy in providing an end wall which is rigidly affixed in the body and the 408 patent calls this an end wall or ring member 9 [R. 285, Col. 1, lines 53-55].

This end wall 9 is for the identical purpose of the 787 patent. It was put there to enable the appellants to assemble their clamp. It is not a washer such as the one disclosed in *appellees'* device, Exhibit 11. The washer in *appellees'* device is free and is a mere load member to take the pressure at the end of the spring as can be seen by an examination of cutaway models and Exhibit 11. The end cap is made of comparatively thin material and as the spreader merely floats on this cap, it might cut its way through the end cap if the spring contacted the spreader in an irregular manner. Therefore, a safety washer has been applied to the device. In fact, as the exhibits show, in some clamps the washer was left out. It is not necessary to the operation of *appellees'* clamp. But the end wall permanently affixed is a necessary item to both the patents in suit as otherwise neither patent describes anything new.

There Is Nothing Inventive Disclosed in the 787 Patent Over the Prior Patents to Rocroy and De Mooy.

There is nothing inventive disclosed in the 787 patent over the prior patents to Rocroy and De Mooy [Exhibits H-4 and H-7, R. 303-317]. The 787 patent in suit discloses a clamp which is identical with the prior art patents to Rocroy and De Mooy with one exception. That exception is that over the end wall of the body of these prior patents Wallace has added an end cap for the purpose described in the patent of keeping "a minimum contact surface . . . to minimize the chance of marring the surface of the work." [R. 279, Col. 2, lines 16-20.]

An examination of the De Mooy patent, Exhibit H-7, discloses that the body (cup shaped housing 10) has an end wall (base 12), a central bore 13 for the retaining pins (retainer 20) with a spreader 15 mounted on the exterior surface of the end wall 12 in a groove 14. The spreader 15 is held in place by closing the outer ends of the groove 14. Comparing this prior patent to the patent in suit, we find that the Wallace 787 patent describes a body 10 having an end wall 12 with a bore therethrough through which is passed the retaining pin 19. On the exterior surface of the end wall 12 of the 787 patent is described a slot 16 into which is inserted the head of the spreader (cross bar 25). To hold this spreader in position in the slot 16 Wallace closes the slot just as does De Mooy. This closure is a cap 27 (end cover cap). The only thing that could possibly be called new in the 787 patent is the device for closing the slot 16. De Mooy teaches that it should be closed by "partly closing the outer ends of the groove." Wallace closes the slot by completely covering it with a cover

cap. Functionally all the elements of the Wallace 787 patent are found in the De Mooy patent. One closes the slot holding the spreader in position by crimping or peening the slot together, the other by adding a piece of metal called an end cover cap, which is crimped around the end of the body. The body with its end wall, the retaining pin, the spreaders and the spring are identical.

These clamps first came into extensive use with the enormous increase in the aircraft industry during the years 1939-1946. Prior to this there had been practically no use for this type of tool. As shown by the record in this case and the Court's decision in the prior *Monogram* case, both parties entered this industry in 1941. At that time there were clamps on the market. A large number of patents had issued or been applied for upon these simple devices. The appellants set upon the proposition of attempting to secure a monopoly upon the industry. For this purpose they solicited and secured a large number of patents, amongst which are the two patents held invalid in the prior *Monogram* suit, the two patents at issue in this case, Exhibit 23 and Exhibit H-11. Each and every one of these patents is for a trifling difference from the original inventions of Rocroy and De Mooy. At the same time many others secured patents on the same devices. The record discloses patents to A. T. S. Co., Le Blanc, De Mooy, Webb and Rogers [Exhibits H-3, 5, 6, 8 and 9, respectively]. There are also the patent not in evidence but originally declared by appellant to be infringed [R. 3, 4], and the patent to

the appellees [R. 12], which was the substance of the Counterclaim. All of these patents clearly illustrate the principle as defined in *Atlantic Works v. Brady*, 107 U.S. 194, 197, where the Court said:

“The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences.

“The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and

gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.”

This case and the former *Monogram* case fully illustrate that when there is a demand for a device or tool any ordinary mechanic can immediately see dozens of different ways of improving the devices already on the market. In this case Wallace changed the prior patents to Rocroy, De Mooy and Webb only by adding a cover cap over the end wall. This change amounts to nothing more than mechanical skill; in fact, it is a mere selection of an obvious way to close the groove of De Mooy. It is old and well known that a cover cap can close a slot, open end barrel or the ends of a tin can. *Mettler v. Peabody Engineering Corp.*, 77 F. 2d 56, 57 (C.C.A. 9); *Eagle, et al. v. P. & C. Hand Forged Tool Co.*, 74 F. 2d 918 (C.C.A. 9); *Magarian v. Detroit Products Co.*, 128 F. 2d 544 (C.C.A. 9). Mere selection of well-known parts to act in their old well-known manner is not invention.

**The Claims of the Patent 408 Are Invalid as They
Constitute Nothing But a Collection of Old Ele-
ments Operating in Their Well-Known Manner
to Accomplish No New Results.**

The claims of the patent 408 are invalid as lacking invention over the patents to Rocroy, De Mooy, Webb and Wallace 787.

The 408 patent describes a well-known clamp which has no new novel element or combination of elements. The basic elements of this patent comprise a body, a retaining pin, a spreader and a spring, all of which were old in Rocroy and De Mooy. In addition, this patent discloses a cover cap as shown in the 787 patent. The 787 patent is prior art to the 408 patent as devices constructed in accordance with the 787 patent were on sale as early as March 1941, more than two years prior to the filing date (April 9, 1943) for the 408 patent [R. 74-93].

The 787 patent discloses the use of an end cap. That element is not new with the 408 patent. Webb discloses the interlocking shoulders which prevent the explosion of the cap. The basic combination of either Rocroy or De Mooy, the end cap of Wallace 787, and the safety lock of Webb form the 408 patented device. None of these elements functioned in any new or different manner than they did in their respective patents and their combination does not add any function to the final tool that is not secured in the other patents. This 408 patent is invalid.

Mere selection of well-known parts to act in their old and well-known manner is not invention.

* * * “That the new combination accomplishes a better result does not alone evidence invention. “The union of the selected elements may be an improvement upon anything the art contains, but, if, in combining them, no novel idea is developed, there is no patentable invention, however great the improvement may be.”

* * * * *

“It is not necessary that all of the elements of the claim be found in one prior patent. If they are all found in different prior patents and no new functional relationship arises from the combination, the claim cannot be sustained.

* * * * *

“All of the elements of the patent in suit were present in the prior art, and combining these elements to make the patented device did not involve invention. * * *” (*Mettler v. Peabody Engineering Corp., et al.*, 77 F. 2d 56, 57 (C.C.A. 9).) See also:

Eagle, et al. v. P. & C. Hand Forged Tool Co., 74 F. 2d 918 (C.C.A. 9).

Magarian v. Detroit Products Co., 128 F. 2d 544 (C.C.A. 9).

Claim 11 of the 787 Patent Is Invalid as the Subject Matter of Said Claim Was in Public Use and on Sale More Than One Year Before the First Disclosure Thereof to the Patent Office.

Claim 11 of the 787 patent is invalid as the subject matter of said claim was in public use and on sale more than one year before the first disclosure thereof to the Patent Office. Claim 11 of the 787 patent (the only claim before this Court) was added by way of amendment to the application for this patent on November 8, 1944. This claim was application claim 33 [File Wrapper Exhibit 3, page 51]. The application for this patent was filed April 7, 1941. Appellants' Vice-President and General Manager, Mr. E. R. Livingston, testified that devices embodying this claim were manufactured and sold as early as March, 1941 [R. 74 and 93]. Under the Patent Statute a person is entitled to Letters Patent if his invention has not been "in public use or on sale in this country for more than one year prior to his application, * * *." *R.S.U.S. 4886, 35 U.S.C.A., § 31.*

The Supreme Court of the United States, in *Muncie Gear Works v. Outboard M. and Mfg. Co.*, 315 U. S. 759, at 768, has held that where a party first claimed as his invention a device which was in public use or on sale in this country for more than one year prior to the presentation of the claim to the Patent Office (whether by an original application or *by amendment* of an application), a claim so lately presented to the Patent Office was invalid.*

In the present case the appellants now assert that claim 11 should not be read to include an end wall in the

*It should be noted that R.S.U.S. 4886 at the time of the *Muncie Gear Works* case read "two years" while the present statute and the one controlling the patent in suit reads "one year."

body [Appellants' Opening Brief, R. 19]. If this is so and the Court could so interpret claim 11, then under the *Muncie Gear Case*, *supra*, this claim is invalid as the same was not presented to the Patent Office until November, 1944, while the Vice-President of the corporate appellant has testified that these devices were on sale as early as March, 1941. All of the claims in the application for the patent in suit (prior to the amendment which added application claim 33 (claim 11 of the patent in suit)) specifically referred to a wall closing one end of the bore [claim 1 of the patent in suit, R. 280] and the appellants urged (during the prosecution of the patent application of all of the other claims) that all of them included a "slotted end wall 12" which formed a composite end closure and that the term "end closure member" meant the combination of the slotted end wall 12 and the cap 27 [File Wrapper Exhibit 3, page 45]. Appellants always insisted to the Patent Office prior to the addition of application claim 33 (patent claim 11) that the claims of the application called for the end wall 12. They cannot now be heard to interpret these claims to the contrary, see *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279; *Hubbell v. United States*, 179 U.S. 77, 83; and *Lorraine v. Townsend*, 290 Fed. 54, 59 (C.C.A. 9). This case can not be distinguished from the *Muncie* case. The only claim according to appellants' own assertion, which claims as invention a body member which does not have an end wall is claim 11 which was added more than one year after the first public sale. This claim is invalid under R.S.U.S. 4886. It should be noted in passing that the defense sustained in the *Muncie Gear Case*, *supra*, was raised *sua sponte* by the Supreme Court and it is not necessary to separately plead the defense where testimony, as in this case, shows prior use.

The Award of Attorneys' Fees to the Defendants in This Case Was Not an Abuse of Discretion.

The award of attorneys' fees to the defendants in this case was proper. 35 U.S.C.A. § 70 provides: “* * * The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.”

In the present case the District Court exercised its discretion and awarded the defendants Five Hundred Dollars (\$500) as attorneys' fees. This statute makes the awarding of the attorneys' fees purely a matter of the lower court's discretion. Unless there has been abuse of discretion by the lower court, an appellate court will not reverse this award. Certainly this Court can take judicial notice of the fact that, in a contested patent case which takes two and one-half days in court to try, even without considering any time for preparation of the case, a larger sum than the attorneys' fees awarded in this case would be justified. This Court will not substitute its discretion for that of the District Court in fixing the amount.

The lower court did not indicate the reasons for awarding attorneys' fees. There are in this case extraordinary circumstances which could have formed the basis for the award of attorneys' fees. This case is the result of a period of four to five years of harassment of the present appellee, Donald H. Finkle, by the two appellants. He has been forced to defend his business against two unjustified patent infringement suits by these appellants. In these two suits four patents were involved, all on extremely minute differences from the basic device in the Rocroy and De Mooy patents, Exhibits H-4 and H-7. In the prior litigation between these parties (*Monogram Mfg. Co. v. F & H Mfg. Co., supra*), the Court

held the patents there in suit invalid in view of the patents to Rocroy and De Mooy, which are the same patents as Exhibits H-4 and H-7 in this litigation. Also, the Court held those patents invalid over the prior use and manufacture by Finkle, who is the Donald H. Finkle of this case. Appellants have insisted that they were the first to use two-pin type of clamps. This is false, as the decision in the former *Monogram* case held Finkle (Donald H. Finkle) to be a prior user.

In the prior case the named appellee was the F & H Mfg. Co., which was a partnership, one of the major partners being Donald H. Finkle. That case was a declaratory judgment action enjoining the appellants herein from threatening appellee's customers with infringement suits.

The present appellee (Donald H. Finkle) has been harassed, not only by the litigation of the present and the former suit, but by the continued threats of appellants against appellee's customers. There is no insistence here that there has been a violation of the injunction against this practice that was awarded in the prior case. When the patents in this case issued, the threats to the customers were all directed to these two new patents. This long campaign of threats and of actual litigation by appellants may have been an added reason for the award of attorneys' fees in this case.

Conclusion.

Appellees respectfully submit that the appealed judgment should be affirmed.

The respective claims of the Wallace patents asserted to be infringed must be interpreted in a way that they do not read on appellees' device, otherwise the claims are invalid as anticipated and lacking in invention as appellees' device is in no way different than the prior art cited.

Respectfully submitted,

LYON & LYON,

FREDERICK W. LYON,

Attorneys for Appellee.

